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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,987	07/31/2003	Gregory T. Hulan	10991815-3	2196

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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ROBINSON, MYLES D

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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10/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/631,987

Applicant(s)

HULAN, GREGORY T.

Examiner

Myles D. Robinson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3 - 7, 9 and 12 - 29 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 26 - 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 7, 9, 12 - 17, 19 - 25 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/30/2006 has been entered.

### ***Election/Restrictions***

2. Applicant's election of Group I in the reply filed on 7/13/2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Response to Amendment***

3. Applicant's amendment was received on 7/13/2007, and has been entered and made of record. Currently, **claims 1, 3 – 7, 9, 12 – 17, 19 – 25 and 29** are pending.

### ***Response to Arguments***

4. Applicant's arguments filed 7/13/2007 have been fully considered but they are not persuasive.

Regarding **claims 1 and 6**, the Applicant argues that **Jamzadeh et al.** (U.S. Patent No. 4,994,827) in view of **Suzuki** (U.S. Patent No. 4,706,099) does not disclose, teach or suggest the automation of printing first copies on first sheets and second copies on second sheets (see *Remarks 11/30/2006 [pages 9 – 10]*).

However, the court has held that broadly providing an automatic or mechanical means to replace a manual activity, which accomplished the same result, is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 12 USPQ 193, 194 (CCPA 1958).

Therefore, the Applicant's arguments regarding claims 1 and 6 are considered not persuasive. Please cite rationale of the grounds of rejection below for further explanation.

### ***Claim Objections***

5. **Claim 1** is objected to because of the following informalities: typographical error in line 5. It is suggested that "a plurality of different a standard photo sizes" be revised to read "a plurality of different **[[a]]** standard photo sizes." Appropriate correction is required.

### ***Double Patenting***

6. **Claims 1, 12, 13, 17 and 19** are objected to under 37 CFR 1.75 as being a substantial duplicates of **claims 6, 20, 21, 25 and 29**, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the

same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claim 5** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 5** recites the limitation "the means" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. **Claim \*\*\*** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Jamzadeh et al.** (U.S. Patent No. 4,994,827) in view of **Suzuki** (U.S. Patent No. 4,706,099) and further in view of **Fukushi** (U.S. Patent No. 6,226,105)

Referring to **claim 1**, Jamzadeh discloses an apparatus for scanning an image and printing copies of the image on a sheet (see *Fig. 1 [column 3, lines 52 – 65]*), the apparatus comprising:

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a scan module (see Fig. 1, color scanner 40 [column 4, lines 15 – 25]),  
a print module (see Fig. 1, electronic exposure station 3 [column 4, lines 44 – 48]),  
an input device (see Fig. 1, operator control panel displays print size designation portion 45 as input for logic and control 30 [column 4, lines 31 – 37]) for allowing a plurality of different a standard photo sizes to be selected (see Fig. 1, print size designation portion 45 [column 4, lines 35 – 44), and  
a controller (see Fig. 1, logic and control 30 [column 4, lines 29 – 35]) operable to:

cause the scan module to scan images from originals in response to a selection via the input device (see Fig. 1, scanner 40 scans an original to be printed [column 4, lines 17 – 20] and see Fig.1 wherein print size designation portion 45 allows for user input regarding desired photo sizes for printout [column 4, lines 35 - 44),

generating first copies of a first scanned image of an original to a first selected photo size (column 4, lines 40 – 44),

generating second copies of a second scanned image of that original to a second selected photo size (see column 4, lines 27 – 30 and 40 – 44 wherein one of ordinary skill in the art would use the invention multiple times to scan different originals and wherein scanned images are stored into memory 43 which must have substantial storage space to suitably meet system demands of those plurality of different originals),

cause the print module to print first copies on a first sheet (*see Fig. 1 wherein print size designation 45 allows user to select a printout of one particular size [column 4, lines 35 – 44 and column 5, lines 1 – 29]*), and

cause the print module to print the second copies on a second sheet (*see column 4, lines 35 – 44 and column 5, lines 1 – 29 wherein one of ordinary skill in the art would use the invention multiple times to print another printout of another particular size different from the previous printout of one particular size*).

All scanners inherently scan originals of different sizes, wherein the sizes of originals to be scanned can range from:

- a) original sizes smaller than the scanning area of the scanner,
- b) original sizes exactly the same size as the scanning area, and
- c) original sizes somewhat larger than the scanning area.

However, Jamzadeh does not explicitly disclose the apparatus further wherein the scan module scans originals of varying sizes, and further comprising a controller operable to: automatically cause the print module to print copies, automatically determine actual sizes of scanned images, automatically scale first copies of a first scanned image of an original to a first selected photo size, automatically scale second copies of a second scanned image of that original to a second selected photo size.

Suzuki discloses an apparatus comprising a controller (*see Fig. 5, control unit 170 [column 4, lines 51 – 62 and column 6, lines 4 – 7]*) operable to:

automatically determine actual sizes of scanned images (see *Fig. 7 wherein the value for the image size on the sending side is analogous to the actual size of the scanned image [column 2, lines 33 – 50 and column 6, lines 29 – 42]*),

automatically scale first copies of a first scanned image of an original to a first selected photo size (see *Figs. 6a – 6d and 7 wherein the magnifying ratio calculated based upon the value for the image size on the data sending size and size designation made on the printer side is analogous to scaling the scanned image to the selected photo size [column 2, lines 33 – 50 and column 6, lines 29 – 57]*),

scale second copies of a second scanned image of that original to a second selected photo size (see *column 5, lines 10 – 14 wherein a plurality of images are processed at one time and see column 2, lines 33 – 50 and column 6, lines 29 – 57 wherein one of ordinary skill in the art would use the invention multiple times to scale different scanned images*) but does not explicitly disclose the apparatus further wherein the scan module scans originals of varying sizes, and further comprising a controller operable to: automatically cause the print module to print copies.

Fukushi discloses the apparatus wherein the scan module scans originals of varying sizes (see *Figs. 1 – 2 [column 1, lines 44 – 49 and column 5, lines 24 – 35]*) but does not explicitly disclose the apparatus further comprising a controller operable to: automatically cause the print module to print copies.

Although Jamzadeh discloses the logic and control 30 receives the print size designation for the scanned original and then supplies the image data and control panel



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inputs to the RIP for print processing (*column 4, lines 35 – 48*), Jamzadeh does not explicitly disclose the automation of such steps causing printing of the copies.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to automate the printing of scanned copies since it has been held that broadly providing an automatic or mechanical means to replace a manual activity, which accomplished the same result, is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 12 USPQ 193, 194 (CCPA 1958).

A suggestion/motivation exists. Many people often prefer automation over human effort because automation allows for the optimization of people's time and resources that are normally consumed for manual, labor-intensive procedures. In other words, the motivation to automate procedures that can normally be done manually is to allocate those same resources and time spent to other unrelated efforts while effectively achieving the same outcome as if the procedure were implemented by hand. Case in point, the teachings of Jamzadeh do not explicitly disclose the automation of printing the copies. However, the teachings of Jamzadeh would be modified by one of ordinary skill in the art at the time of the invention to automate such steps in order for the operator to pursue other efforts instead of waiting to manually input another command to print the copies. *In re Venner* holds that providing automation to replace manual activity, which accomplished the same result, would have been obvious.

Jamzadeh and Suzuki are combinable because they are from the same field of endeavor, being copying images of different sizes onto sheets of different sizes while avoiding wasting space. At the time of the invention, it would have been obvious to one

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of ordinary skill in the art to include determining the size of the scanned image and scaling the image data to the selected photo size. The suggestion/motivation for doing so would have been to easily copying images of various sizes, as suggested by Suzuki (*column 2, lines 33 – 49*). Furthermore, since Jamzadeh already points one with ordinary skill in the art toward the teachings of Suzuki which deal with how the printed image data is generated from scanned image data, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified the teachings of Jamzadeh to include determining the size of the scanned image and scaling the copies of the scanned originals to a selected photo size, as taught by Suzuki.

Jamzadeh and Fukushi are combinable because they are from the same field of endeavor, being reproducing user-defined sizes of images. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include scanning images from originals of varying sizes. The suggestion/motivation for doing so would have been to conveniently allow users the flexibility of scanning photographs of various sizes, as suggested by Fukushi (*column 1, line 44 – column 2, line 22*).

Referring to **claim 3**, Jamzadeh discloses the apparatus further comprising a means for rotating at least one copy to utilize maximum printable area on the first or second sheet (*see Fig. 4 wherein 5x7 images have been rotated [column 5, lines 17 – 21]*).

Referring to **claim 4**, Jamzadeh discloses the apparatus further wherein the input device is configured to display selectable entries each corresponding to a different standard photo size (*column 4, lines 35 – 40*).

Referring to **claim 5**, Jamzadeh discloses the apparatus further wherein sets of standard photo sizes are programmably stored in the means (*column 4, lines 31 – 45 wherein logic and control 30 inherently stores values for print size designation*).

Referring to **claims 12 and 13**, Suzuki discloses the apparatus further wherein the controller is operable to cause the print module to print the first and second copies of the scanned image on the first and second sheets using a single resolution for printing photos (*column 1, lines 65 – 68*).

Jamzadeh discloses the apparatus using mixing color dots to create colors (*column 3, lines 50 – 65*).

Referring to **claim 14**, Jamzadeh discloses the apparatus further wherein at least one entry is configured to convey information that is at least indirectly related to a maximum printable area on a sheet (*see Figs. 3 – 4 [column 3, lines 1 – 5, column 4, lines 35 – 40 and column 5, lines 1 – 30]*).

Referring to **claims 15 and 16**, Fukushi discloses the apparatus further wherein the standard photo sizes are in metric units of measure or in English units of measure (*column 6, lines 50 – 55 wherein the teachings of Fukushi include metric unit teachings; however, a person from another country (i.e. United States) with ordinary skill in the art at the time the invention was made would be inclined to utilize well-known metric-to-English unit conversions; likewise, a person from a country other than the United States,*

*for example, with ordinary skill in the art at the time the invention was made would be inclined to utilize well-known English-to-metric unit conversions).*

Referring to **claim 17**, Fukushima discloses the apparatus further wherein the original is a photograph (*column 1, lines 7 – 12 and 43 – 49*).

Referring to **claim 19**, Jamzadeh discloses the apparatus further wherein the apparatus is a digital copying machine (*see Fig. 1 [column 7, lines 52 – 55]*).

Referring to **claims 6, 20, 21, 23 – 25 and 29**, the rationale provided in the rejections of claims 1, 12, 13, 15 – 17 and 19, respectively, are incorporated herein. In addition, the apparatuses of claims 1, 12, 13, 15 – 17 and 19 include the elements and limitations of the apparatuses of claims 6, 20, 21, 23 – 25 and 29, respectively.

Referring to **claim 7**, Jamzadeh discloses the apparatus further wherein the apparatus is an All-in-One machine (*column 3, lines 52 – 57*).

Referring to **claim 9**, Jamzadeh discloses the apparatus further wherein the input device is configured to prompt for additional standard sizes (*column 4, lines 35 – 40*).

Referring to **claim 32**, Jamzadeh discloses the apparatus further wherein the controller is operable to:

automatically position the scaled first scanned image copies to utilize maximum printable area on the first sheet (*see Figs. 3 – 4 [column 3, lines 1 – 5, column 4, lines 35 – 40 and column 5, lines 1 – 30]*), and

automatically position the scaled second scanned image copies to utilize maximum printable area on the second sheet (*see Figs. 3 – 4 wherein one of ordinary skill in the art would use the invention multiple times to position different scanned*

*images of different sheets of given different areas [column 3, lines 1 – 5, column 4, lines 35 – 40 and column 5, lines 1 – 30]).*

Referring to **claim 22**, Jamzadeh discloses the apparatus further wherein the input device includes a set of entries for different standard photo sizes corresponding to maximum printable area on a sheet (see *Figs. 3 – 4 [column 3, lines 1 – 5, column 4, lines 35 – 40 and column 5, lines 1 – 30])*).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571) 272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MDR

9/27/07



TWYLER LAMB  
SUPERVISORY PATENT EXAMINER